Remarks

Applicant has amended claims 1, 15, 21, 26-28, 30 and 32. Applicant respectfully submits that no new matter was added by the amendment, as all of the amended matter was either previously illustrated or described in the drawings, written specification and/or claims of the present application. Entry of the amendment and favorable consideration thereof is earnestly requested.

The Examiner has rejected claims 1-4, 6, 7, 9, 12, 15-27, and 32 under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 7,031,471 (Stefik et al.) in view of U.S. Application Serial No. 2003/2208494 (King et al.) and U.S. Patent No. 7,259,878 (Ishida et al.).

All of the pending claims recite a printed document that includes a mark on each page of the documents that the mark has data unique to each page of the document. The mark is provided such that unauthorized copying and/or alteration is prevented. As the examiner has pointed out, Stefik et al. fails to teach a printed document with a mark on each page of the document where data is unique to each page of the document. Likewise, King et al. also fails to teach this, rather it teaches "validating the verity of an electronically generated and authenticated document ... whereby both the contents and signatures may be matched to one another" (¶5). This is achieved by applying a barcode to each page of the defined electronic document, and then applying a secure algorithm to the entire electronic document to generate a unique digital exchange key, which is stored in connection with the defined electronic document. (¶7). There is no mark that is printed on each page of the document that has data unique to each page of the printed document that would prevent any type of copying.

The examiner acknowledges that "Stefik et al. and King et al. fail to teach wherein unauthorized copying and/or alteration of the printed digital file is prevented." (Official Action, 12/28/09, p. 3). However, the examiner goes on to state that Ishida et al. teach-

es that "unauthorized copying and/or alteration of the printed digital file is prevented." (*Id.*) In particular, the examiner references Ishida et al. stating,

> In step S70, it is determined whether or not the image is a copy-prohibited image based on the result of the check in step S60. If the result of the determination of step S70 is affirmative, the process proceeds to step S80. If the result of the determination in step S70 is negative, the process proceeds to step S90. (31) In step S80, abnormal image data is output. That is as described above, an abnormal image (other than the read image data) represented by (1) image data entirely painted with a certain color, (2) image data obtained by superposing a certain symbol or figure on the image, (3) image data in which the color or the image size is changed, or a combination of these image data is output) (col. 6, lines 35-57).

(Official Action, 12/28/09, pp. 3-4). Ishida et al. is directed toward a system for "preventing counterfeiting of paper money, securities and the like." (Col. 1, lns. 15-17). In other words, Ishida et al. is concerned with preventing someone from digitally scanning, for example, paper money and then duplicating the paper money. It teaches that this can be accomplished by use of "a copy-prohibited-object recognition unit 130 for determining whether or not the image data obtained by the image-data acquisition unit 120 is mage data obtained by reading a copy-prohibited object." (Col. 4, lns. 28-31). Ishida et al. teaches the counterfeiting can be prevented by use of a "retry determination unit 160 including a difficulty calculation unit 140 for calculating the difficulty in determining whether or not the image data represents a copy-prohibited object." (Col. 4, lns. 31-34). Accordingly, Ishida et al. teaches that a scanned image is analyzed to determine whether or not the image is copy-prohibited-object and provides a difficulty calculation unit for determining whether the system should rescan. If the scanned data is determined to be a copy-prohibited-object, the system alters the scanned image thereby preventing counterfeiting of, for example, paper money. This is a very different system that is described and claimed in the present application.

As amended, the claims recite that "unauthorized copying and/or alteration of the printed digital file is prevented by means of the mark containing data unique to each

page of the printed file." This is not taught by any of the cited references. For example, as stated above, neither Stefik et al. nor King et al. teach that the marks provided by those systems include data unique to each page that prevents copying of the printed document. Likewise, Ishida et al. does not teach this limitation, but rather teaches a system that analyzes a scanned image to determine if the image falls into a category of documents that are prohibited from being duplicated. There is no teaching that a mark is provided on each page of a document and that the mark includes data unique to each page of the document and that copying is prevented by means of the mark. Ishida et al. does not teach that a mark prevents copying, but rather it is an internal unit that analyzed the entire scanned object and compares this to a database of identified features to see if it should or should not allow the process.

Obviousness requires a suggestion of all the elements in a claim (*CFMT, Inc. v. Yieldup Int'l Corp.*, 349 F.3d 1333, 1342 (Fed. Cir. 2003)) and "a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741, 82 USPQ2d 1385 (2007). Here, we find that the Examiner has not identified all the elements of the claims (e.g., "unauthorized copying and/or alteration of the printed digital file is prevented by means of the mark containing data unique to each page of the printed file"), nor provided a reason that would have prompted the skilled worker to have arranged them in the manner necessary to reach the claimed invention (in fact, the motivation provided to combine King et al. with Stefik et al. "to validate the verity of the digital file" has nothing to do with preventing the unauthorized copying of a printed document but rather is solely used for electronic verification.)

A rationale to support a conclusion that a claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yielded nothing more than predictable results to one of ordinary skill in the art. *KSR International Co. v. Teleflex Inc.*, 127

S.Ct. 1727, 1741, 82 USPQ2d 1385, 1395 (2007); *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282 (1976). Here we see that the marks indicated by King et al. are not provided for, nor can they prevent unauthorized copying nor does Ishida et al. teach this.

It is respectfully submitted that claims 1-28, 30 and 32, all of the claims remaining in the application, are in order for allowance and an early notice to that effect is respectfully requested.

Respectfully submitted,

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